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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/735,162  | 12/11/2003  | Hawley K. Rising III | 80398.P534C         | 1651             |
| 7590  | 10/31/2005  |                      |                     | EXAMINER         |
| Sheryl Sue Holloway<br>BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP<br>Seventh Floor<br>12400 Wilshire Boulevard<br>Los Angeles, CA 90025 |             |                      | PARDO, THUY N       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2165                |                  |
| DATE MAILED: 10/31/2005   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/735,162             | RISING, HAWLEY K.   |  |
|                              | Examiner<br>Thuy Pardo | Art Unit<br>2165    |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 15 August 2005 and 22 August 2005.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 21-132 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 21-132 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 15 August 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/22/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. Applicant's Amendment filed on August 15, 2005 and IDS filed on August 22, 2005 in response to Examiner's Office Action have been reviewed.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-132 are rejected under the judicially created doctrine of double patenting over claims 1-15 of U. S. Patent No. 6,721,759 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: performing a hierarchical data structure of root and leaf nodes representing a multidimensional scaling database defined by a set of points that correspond to a set of objects.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 21, 31, 40, 49, 59, 68, 77, 87, 96, 105, 115 and 124 are rejected under 35 U.S.C. 102(e) as being anticipated by Becker US Patent No. 6,301,579.

As to claim 21, Becker teaches the invention substantially as claimed, comprising:  
creating a root node [1102 of fig. 11A] comprising coordinates in the MDS space for a first subset of the set of points [col. 3, lines 50-60] the root node further comprising boundary information in the MDS space for local MDS spaces defined by further subsets of the set of points [col. 7, lines 38 to col. 8, lines 29]; and

creating a plurality of leaf nodes [1114, 1116, 1118 of fig. 11A], each leaf node [B of fig. 12] comprising coordinates in a local MDS space for the points in one of the further subsets [Cs of fig. 12].

As to claim 40, Becker teaches the invention substantially as claimed, comprising identifying a node for a new point corresponding to a new object based on attribute proximities between the new object and existing objects [col. 17, lines 59 to col. 18, lines 62; col. 20, lines 48-64].

As to claims 31, 49, 59, 68, 77, 87, 96, 105, 115 and 124, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

***Allowable Subject Matter***

4. Claims 22-30, 32-39, 41-48, 50-58, 60-67, 69-76, 78-86, 88-95, 97-104, 106-114, 116-123 and 125-132 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As to claims 22, 50, 78 and 106, the feature of selecting the first subset of points based on the distances between pairs of points, taken together with other limitations of claims 21, 49, 77 and 105 was not disclosed by the prior art of record.

As to claims 24, 52, 80 and 108, the feature that creating a root node comprises running MDS on the first subset of points to define the MDS space, taken together with other limitations of claims 21, 49, 77 and 105 was not disclosed by the prior art of record.

As to claims 25, 53, 81 and 109, the feature that creating a plurality of leaf nodes comprises iteratively grouping the points remaining after selecting the first subset into the further subsets based on coordinates in the MDS space of the remaining points, taken together with other limitations of claims 21, 49, 77 and 105 was not disclosed by the prior art of record.

As to claims 29, 57, 85 and 113, the feature that each node further comprises a map relating distances between pairs of points in the associated MDS space with the attribute proximities between the corresponding objects, taken together with other limitations of claims 21, 49, 77 and 105 was not disclosed by the prior art of record.

As to claims 30, 58, 86 and 114, the feature that the leaf nodes further comprise coordinates for any overlapping portions of the associated local MDS spaces, taken together with other limitations of claims 21, 49, 77 and 105 was not disclosed by the prior art of record.

As to claims 32, 41, 60, 69, 88, 97, 116 and 125, the feature of adding the new point into the subset associated with the identified node and redefining the local MDS space for the identified node, taken together with other limitations of claims 21 and 31, 49 and 59, 77 and 87, 105 and 115, 40, 68, 96 or 124 was not disclosed by the prior art of record.

As to claims 38, 47, 66, 75, 94, 103, 122 and 131, the feature of determining points in the subset associated with the identified node that are within a pre-determined distance of the new point, taken together with other limitations of claims 21 and 31, 49 and 59, 77 and 87, 105 and 115, 40, 68, 96 or 124 was not disclosed by the prior art of record.

Claims 23, 26-28, 33-37, 39, 42-46, 48, 51, 54-56, 61-65, 67, 70-74, 76, 83-85, 89-93, 95, 98-102, 104, 107, 110-112, 117-121, 123, 126-130 and 132 being further limiting to claims 21 and 31, 49 and 59, 77 and 87, 105 and 115, 40, 68, 96 or 124 are also objected to.

#### *Response to Arguments*

5. Applicant's arguments filed on August 15, 2005 have been fully considered but they are not persuasive.

Applicant argues that Becker teaches the opposite function of what applicant claims. As to this point, Examiner respectfully disagrees. Becker teaches creating a multi-dimensional data structure in which the data structure comprises one or more levels arranged in a hierachal manner (a root node and a plurality of leaf nodes) as the same as the function of what Applicant

claims. Furthermore, the feature that data in spatial arrangement based on similarity or dissimilarity is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

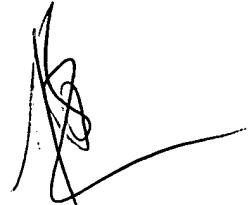
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Pardo whose telephone number is 571-272-4082. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 28, 2005



THUY N. PARDO  
PRIMARY EXAMINER